

**REMARKS**

Claims 15 and 17 to 28 are now pending in the present application.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 15 and 17 to 28 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

While the indefiniteness rejections may not be agreed with, to facilitate matters, claim 15 has been rewritten to better clarify the claimed subject matter. The term "relative dielectric constant" has been replaced by "relative static permittivity." Withdrawal of the indefiniteness rejections is therefore respectfully requested.

Claims 15, 17 to 19 and 23 were rejected under 35 U.S.C. § 102(b) as being anticipated by European Patent Application No. EP 0 995 639 A2 ("Boran").

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Claim 15, as presented, includes the feature of *at least one piezo cable, in which the piezo cable is configured such that the device detects a capacitance change by an impact object with the aid of the piezo cable, and in which the device is configured to characterize the relative static permittivity of the impact object based on the capacitance change.*

The “Boran” reference does not identically disclose (nor even suggest) the feature in which *the device is configured to characterize the relative static permittivity of the impact object based on the capacitance change*, as provided for in the context of the presently claimed subject matter. Accordingly, the “Boran” reference does not anticipate claim 15.

For at least the foregoing reasons, claim 15 is allowable, as are its dependent claims 17 to 19 and 23.

Claims 20 to 22 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boran in view of U.S. Patent No. 6,534,999 B2 (“Brown”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 20 to 22 and 25 depend from claim 15, and are therefore allowable for

essentially the same reasons, since the secondary "Brown" reference does not overcome — and is not asserted to overcome — the critical shortcomings of the primary "Boran" reference as to claim 15. Withdrawal of the obviousness rejections of claims 20 to 22 and 25 is therefore respectfully requested.

Claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Boran in view of UK Patent Application No. GB 2317707 A ("Bergner").

Claim 24 ultimately depends from claim 15, and are therefore allowable for essentially the same reasons, since the secondary "Bergner" reference does not overcome — and is not asserted to overcome — the critical shortcomings of the primary "Boran" reference as to claim 15. Withdrawal of the obviousness rejection of claim 24 is therefore respectfully requested.

*As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by that Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).*

Claims 26 to 28 were rejected as not distinguishing the claimed structure over the Boran reference.

Claims 26 to 28 depend from claim 15, as presented, and are therefore allowable for essentially the same reasons as claim 15. Withdrawal of the rejections of claims 26 to 28 is respectfully requested.

In summary, all of pending claims 15 and 17 to 28 are allowable.

**CONCLUSION**

In view of the foregoing, it is respectfully submitted that all pending and considered claims 15 and 17 to 28 are in condition for allowance. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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Dated: \_\_\_\_\_

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